

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

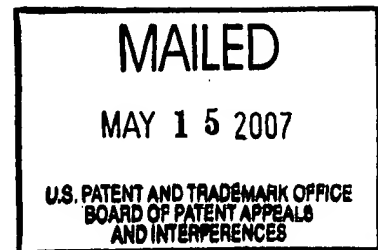
---

Ex parte GREGORY A. KOPIA,  
GERALD H. LLANOS, AND ROBERT FALOTICO

---

Application 09/575,480

---



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

---

This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on April 2, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matter requiring attention prior to docketing is identified below.

An Information Disclosure Statement (IDS) was filed on July 19, 2004. It is not apparent from the record whether the Examiner considered

the statement submitted or notified Appellants regarding why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying Appellants of the Primary Examiner's decision is required.

On December 1, 2005, Appellants filed an Appeal Brief. A review of the file reveals that the "Summary of Claimed Subject Matter" does not map the independent claim(s) or dependent claim(s) argued separately to the specification, as set forth in 37 C.F.R. § 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Correction is required. MPEP § 1205.03 states:

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the

claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

In addition, the Examiner Answer filed on February 24, 2006, reveals that the following appropriate headings are missing. Correction is required. MPEP § 1207.02.

A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

*Claims Appendix.* A statement of whether the copy of the appealed claims contained in the appendix to the brief is correct and, if not, a correct copy of any incorrect claim.

*Evidence Relied Upon.* A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

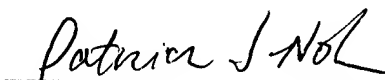
*Grounds of Rejection.* For each ground of rejection maintained by the examiner and each new ground of rejection (if any), an explanation of the ground of rejection.

*Related Proceedings Appendix.* Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the "Related Appeals and Interferences" section of the answer.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- 1) consider the IDS filed July 19, 2004, with appropriate notification to Appellants regarding the Primary Examiner's decision and;
- 2) hold the Appeal Brief filed on December 1, 2005, defective;
- 3) notify Appellants to file a paper providing a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v);
- 4) consider the paper providing a summary of the claimed subject matter as required by 37 C.F.R. 41.37(c)(1)(v) and;
- 5) vacate the Examiner's Answer mailed February 24, 2006 and revised Examiner's Answer having the appropriate headings;
- 6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES



PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
(571)272-9797

PJN:kis

cc: PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933